

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GAMETEK LLC,) Civil No. 12cv0503 BEN(RBB)
)
Plaintiff,) CASE MANAGEMENT CONFERENCE
) ORDER REGULATING DISCOVERY AND
v.) OTHER PRETRIAL PROCEEDINGS
) (Rule 16, Fed.R.Civ.P.) (Local
NHN USA, INC.; NHN CORPORATION;) Rule 1)
IJJI GAMES, LLC; RED DUCK INC.)
)
Defendants.)
_____)
IJJI GAMES, LLC,)
)
Counter-claimant,)
)
v.)
)
GAMETEK LLC,)
)
Counter-defendant.)
_____)
NHN USA, INC.,)
)
Counter-claimant,)
)
v.)
)
GAMETEK LLC,)
)
Counter-defendant.)
_____)

Pursuant to Rule 16 of the Federal Rules of Civil Procedure,
and after previously consulting with the attorneys of record for

1 the parties and being advised of the status of the case, and good
2 cause appearing, IT IS HEREBY ORDERED:

3 1. **Motions to Amend.** Any motion to join other parties, to
4 amend the pleadings, or to file additional pleadings shall be filed
5 on or before December 10, 2012.

6 2. **Disclosure of Asserted Claims and Preliminary**
7 **Infringement Contentions.** On or before July 2, 2012, Plaintiff
8 shall serve on all parties a "Disclosure of Asserted Claims and
9 Preliminary Infringement Contentions." Separately for each
10 opposing party, the "Disclosure of Asserted Claims and Preliminary
11 Infringement Contentions" must contain the following information:

12 a. Each claim of each patent in the suit that is
13 allegedly infringed by each opposing party;

14 b. Separately for each asserted claim, each accused
15 apparatus, product, device, process, method, act, or other
16 instrumentality ("Accused Instrumentality") of each opposing party
17 of which the party is aware. This identification must be as
18 specific as possible. Each product, device and apparatus must be
19 identified by name or model number, if known. Each method or
20 process must be identified by name, if known, or by any product,
21 device, or apparatus which, when used, allegedly results in the
22 practice of the claimed method or process;

23 c. A chart identifying specifically where each element
24 of each asserted claim is found within each Accused
25 Instrumentality, including for each element that the party contends
26 is governed by 35 U.S.C. § 112(6), the identity of the
27 structure(s), act(s), or material(s) in the Accused Instrumentality
28 that performs the claimed function;

1 d. Whether each element of each asserted claim is
2 claimed to be literally present or present under the doctrine of
3 equivalents in the Accused Instrumentality;

4 e. For any patent that claims priority to an earlier
5 application, the priority date to which each asserted claim
6 allegedly is entitled; and

7 f. If a party claiming patent infringement asserts that
8 its own apparatus, product, device, process, method, act, or other
9 instrumentality practices the claimed invention, the party must
10 identify, separately for each asserted claim, each apparatus,
11 product, device, process, method, act, or other instrumentality
12 that incorporates or reflects that particular claim.

13 3. **Document Production Accompanying Disclosure.** With the
14 "Disclosure of Asserted Claims and Preliminary Infringement
15 Contentions," the party claiming patent infringement must produce
16 to each opposing party, or make available for inspection and
17 copying, the following documents in the possession, custody and/or
18 control of that party:

19 a. Documents (e.g., contracts, purchase orders,
20 invoices, advertisements, marketing materials, offer letters, beta
21 site testing agreements, and third party or joint development
22 agreements) sufficient to evidence each discussion with, disclosure
23 to, or other manner of providing to a third party, or sale of or
24 offer to sell, the claimed invention prior to the date of
25 application for the patent in suit. A party's production of a
26 document as required herein does not constitute an admission that
27 the document evidences or is prior art under 35 U.S.C. §102;
28

1 b. All documents evidencing the conception, reduction
2 to practice, design, and development of each claimed invention,
3 which were created on or before the date of application for the
4 patent in suit or the priority date identified pursuant to P.L.R.
5 3.1(e), whichever is earlier; and

6 c. A copy of the file history for each patent in suit.
7 The producing party must separately identify by production
8 number which documents correspond to each category.

9 The party claiming patent infringement is required to use its
10 best efforts to obtain the documents to make a timely disclosure if
11 the documents identified above are not in the possession, custody
12 and/or control of that party.

13 **4. Preliminary Invalidity Contentions.** On or before
14 September 10, 2012, Defendant(s) shall serve on all parties
15 "Preliminary Invalidity Contentions," which must contain the
16 following information:

17 a. The identity of each item of prior art that
18 allegedly anticipates each asserted claim or renders it obvious.
19 Each prior art patent must be identified by its number, country of
20 origin, and date of issue. Each prior art publication must be
21 identified by its title, date of publication, and where feasible,
22 author and publisher. Prior art under 35 U.S.C. § 102(b) must be
23 identified by specifying the item offered for sale or publicly used
24 or known, the date the offer or use took place or the information
25 became known, and the identity of the person or entity which made
26 the use or which made and received the offer, or the person or
27 entity which made the information known or to whom it was made
28 known. Prior art under 35 U.S.C. § 102(f) must be identified by

1 providing the name of the person(s) from whom and the circumstances
2 under which the invention or any part of it was derived. Prior art
3 under 35 U.S.C. § 102(g) must be identified by providing the
4 identities of the person(s) or entities involved in and the
5 circumstances surrounding making the invention before the patent
6 applicant(s);

7 b. Whether each item of prior art anticipates each
8 asserted claim or renders it obvious. If a combination of items of
9 prior art makes a claim obvious, each combination and the
10 motivation to combine the items, must be identified;

11 c. A chart identifying where specifically in each
12 alleged item of prior art each element of each asserted claim is
13 found, including for each element that the party contends is
14 governed by 35 U.S.C. § 112(6), the identity of the structure(s),
15 act(s), or material(s) in each item of prior art that performs the
16 claimed function; and

17 d. Any grounds of invalidity based on indefiniteness
18 under 35 U.S.C. § 112(1) of any of the asserted claims.

19 **5. Document Production Accompanying Preliminary Invalidity**
20 **Contentions.** With the "Preliminary Invalidity Contentions," the
21 party opposing a claim of patent infringement must produce or make
22 available for inspection and copying:

23 a. Source code, specifications, schematics, flow
24 charts, artwork, formulas, or other documentation sufficient to
25 show the operation of any aspects or elements of any Accused
26 Instrumentality identified by the patent claimant in the
27 "Disclosure of Asserted Claims and Preliminary Infringement
28 Contentions;"

1 b. A copy of each item of prior art identified in the
2 Preliminary Invalidity Contentions, which does not appear in the
3 file history of the patent(s) at issue. To the extent any item is
4 not in English, an English translation of the portion(s) relied
5 upon must be produced.

6 **6. Exchange of Proposed Claim Constructions and Extrinsic**
7 **Evidence.**

8 a. On or before October 1, 2012, the parties shall
9 simultaneously exchange a preliminary proposed construction of each
10 claim term, phrase, or clause which the parties have identified for
11 claim construction purposes. Each "Preliminary Claim Construction"
12 will also, for each element which any party contends is governed by
13 35 U.S.C. § 112(6), identify the structure(s), act(s), or
14 material(s) corresponding to that element.

15 b. At the same time the parties exchange their
16 respective "Preliminary Claim Constructions," they must also
17 provide a preliminary identification of extrinsic evidence,
18 including without limitation, dictionary definitions, citations to
19 learned treatises and prior art, and testimony of percipient and
20 expert witnesses they contend support their respective claim
21 constructions. The parties must identify each item of extrinsic
22 evidence by production number or produce a copy of any item not
23 previously produced. With respect to any witness, percipient or
24 expert, the parties must also provide a brief description of the
25 substance of that witness' proposed testimony.

26 c. On or before October 22, 2012, the parties shall
27 simultaneously exchange "Responsive Claim Constructions"
28 identifying whether the responding party agrees with the other

1 party's proposed construction, or identify an alternate
2 construction in the responding party's preliminary construction, or
3 set forth the responding party's alternate construction.

4 d. At the same time the parties exchange their
5 respective "Responsive Claim Constructions," they must also provide
6 a preliminary identification of extrinsic evidence, including
7 without limitation, dictionary definitions, citations to learned
8 treatises and prior art, and testimony of percipient and expert
9 witnesses they contend support any responsive claim constructions.
10 The parties must identify each item of extrinsic evidence by
11 production number or produce a copy of any item not previously
12 produced. With respect to any witness, percipient or expert, the
13 parties must also provide a brief description of the substance of
14 that witness' proposed testimony.

15 e. The parties must thereafter meet and confer for the
16 purposes of narrowing the issues and finalizing preparation of a
17 Joint Claim Construction Chart, Joint Claim Construction Worksheet
18 and Joint Hearing Statement.

19 **7. Joint Claim Construction Chart, Worksheet and Hearing**
20 **Statement.** On or before November 5, 2012, the parties shall
21 complete and file a Joint Claim Construction Chart, Joint Claim
22 Construction Worksheet and Joint Hearing Statement.

23 a. The Joint Claim Construction Chart must have a
24 column listing complete language of disputed claims with the
25 disputed terms in bold type and separate columns for each party's
26 proposed construction of each disputed term. Each party's proposed
27 construction of each disputed claim term, phrase, or clause, must
28 identify all references from the specification or prosecution

1 history that support that construction and an identification of any
2 extrinsic evidence known to the party on which it intends to rely
3 either to support its proposed construction of the claim or to
4 oppose any other party's proposed construction of the claim,
5 including, but not limited to, as permitted by law, dictionary
6 definitions, citations to learned treatises and prior art, and
7 testimony of percipient and expert witnesses.

8 b. The parties Joint Claim Construction Worksheet must
9 be in the format set forth in Appendix A and include any proposed
10 constructions to which the parties agree, as well as those in
11 dispute. The parties must jointly submit the Joint Claim
12 Construction Worksheet on computer disk in both Word and
13 Wordperfect format or in any other format the Court may direct.

14 c. The Joint Hearing Statement must include:

15 1. The anticipated length of time necessary for
16 the Claim Construction Hearing; and

17 2. Whether any party proposes to call one or more
18 witnesses, including experts, at the Claim Construction Hearing,
19 the identity of each witness, and for each expert, a summary of
20 each opinion to be offered in sufficient detail to permit a
21 meaningful deposition of that expert.

22 d. At the Court's discretion, within 5 calendar days of
23 the submission of the Joint Claim Construction Chart, Joint Claim
24 Construction Worksheet and Joint Hearing Statement, the Court will
25 schedule and hold a status conference with the parties, in person
26 or by telephone, to discuss the schedule, witnesses and any other
27 matters regarding the Claim Construction Hearing.

28

1 8. **Completion of Claim Construction Discovery.** The parties
2 shall complete all discovery, including any depositions of any
3 witnesses, including experts, the parties intend to use in the
4 Claim Construction Hearing by December 31, 2012. An expert witness
5 identified in a party's Joint Hearing Statement may be deposed on
6 claim construction issues. The identification of an expert in the
7 Joint Hearing Statement may be deemed good cause for a separate
8 deposition on all substantive issues.

9 9. **Claim Construction Briefs.**

10 a. On or before January 14, 2013, the parties shall
11 simultaneously file and serve opening briefs and any evidence
12 supporting their claim construction.

13 b. On or before January 28, 2013, will conduct a Claim
14 Construction Hearing, to the extent the Court believe a hearing is
15 necessary for construction of the claims at issue.

16 10. **Claim Construction Hearing.** On February 21, 2013, at
17 9:00 a.m., subject to the convenience of the Court's calendar, the
18 Honorable Roger T. Benitez will conduct a Claim Construction
19 Hearing, to the extent the Court believe a hearing is necessary for
20 construction of the claims at issue.

21 11. **Final Contentions.** Each party's "Preliminary
22 Infringement Contentions" and "Preliminary Invalidity Contentions"
23 will be deemed to be that party's final contentions, except as set
24 forth below.

25 a. If a party claiming patent infringement believes in
26 good faith that the Court's Claim Construction Ruling so requires,
27 not later than 30 days after service by the Court of its Claim
28 Construction Ruling, that party may serve "Final Infringement

1 Contentions" without leave of Court that amend its "Preliminary
2 Infringement Contentions."

3 b. Not later than 50 days after service by the Court of
4 its Claim Construction Ruling, each party opposing a claim of
5 patent infringement may serve "Final Invalidity Contentions"
6 without leave of Court that amend its "Preliminary Invalidity
7 Contentions" if: i) a party claiming patent infringement has
8 served "Final Infringement Contentions," or ii) the party opposing
9 a claim of patent infringement believes in good faith that the
10 Court's Claim Construction Ruling so requires.

11 12. **Amendment to Contentions.** Amendment or modification of
12 the Preliminary or Final Infringement Contentions or the
13 Preliminary or Final Invalidity Contentions, other than as
14 expressly permitted in the section above, may be made only by order
15 of the Court, which will be entered only upon a showing of good
16 cause.

17 13. **Expert Witnesses.** On or before April 22, 2013, all
18 parties shall exchange a list of all expert witnesses expected to
19 be called at trial. The list shall include the name, address, and
20 phone number of the expert and a brief statement identifying the
21 subject areas as to which the expert is expected to testify. The
22 list shall also include the normal rates the expert charges for
23 deposition and trial testimony. On or before May 13, 2013, any
24 party may supplement its designation in response to any other
25 party's designation so long as that party has not previously
26 retained an expert to testify on that subject.

27 14. Each expert witness designated by a party shall prepare a
28 written report to be provided to all other parties no later than

1 June 10, 2013, containing the information required by Fed. R. Civ.
2 P. 26(a)(2)(A) and (B). A written report is not required from a
3 witness giving testimony as a percipient expert.

4 **Except as provided in paragraph 15, below, any party that**
5 **fails to make these disclosures shall not, absent substantial**
6 **justification, be permitted to use evidence or testimony not**
7 **disclosed at any hearing or at the time of trial. In addition, the**
8 **Court may impose sanctions as permitted by Fed. R. Civ. P. 37(c).**

9 15. Any party, through any expert designated, shall in
10 accordance with Fed. R. Civ. P. 26(a)(2)(C) and Fed. R. Civ. P.
11 26(e), supplement any of its expert reports regarding evidence
12 intended solely to contradict or rebut evidence on the same subject
13 matter identified in an expert report submitted by another party.
14 Supplemental reports are due on or before July 1, 2013.

15 16. All fact discovery shall be completed on or before June
16 24, 2013. All expert discovery shall be completed on or before
17 August 26, 2013.

18 "Completed" means that all discovery under Rules 30-36 of the
19 Federal Rules of Civil Procedure must be initiated a sufficient
20 period of time in advance of the cut-off date, so *that it may be*
21 *completed* by the cut-off date, taking into account the times for
22 service, notice, response, and any corresponding discovery motions,
23 as set forth in the Federal Rules of Civil Procedure. All disputes
24 concerning discovery shall be brought to the attention of the
25 Magistrate Judge no later than thirty (30) days following the date
26 upon which the event giving rise to the discovery dispute occurred.
27 Counsel shall meet and confer pursuant to the requirements of Fed.
28 R. Civ. P. 26 and Local Rule 26.1(a).

1 17. All motions, other than motions to amend or join parties,
2 or motions in limine, shall be filed on or before September 23,
3 2013.

4 Motions will not be heard or calendared unless counsel for the
5 moving party has obtained a motion hearing date from the law clerk
6 of the judge who will hear the motion. **Be advised that the parties**
7 **must file their moving papers within three (3) days of receiving**
8 **the motion hearing date from the Court. Be further advised that**
9 **the period of time between the date you request a motion date and**
10 **the hearing date may be up to six weeks. Please plan accordingly.**
11 For example, you may need to contact the judge's law clerk at least
12 six weeks in advance of the motion cut-off to calendar the motion.
13 Failure of counsel to timely request a motion date may result in
14 the motion not being heard. **Motions will not be heard on the above**
15 **date unless you have obtained that date in advance from the judge's**
16 **law clerk.**

17 Briefs or memoranda in support of or in opposition to any
18 pending motion shall not exceed twenty-five (25) pages in length
19 without permission of the judge or magistrate judge who will hear
20 the motion. No reply memorandum shall exceed ten (10) pages
21 without leave of the judge or magistrate judge who will hear the
22 motion.

23 18. Further settlement conferences shall be held at
24 appropriate intervals during the course of the litigation in the
25 chambers of Judge Ruben B. Brooks. A mandatory settlement
26 conference date will be set at one of the scheduled settlement
27 conferences.
28

1 All parties, claims adjusters for insured Defendants and non-
2 lawyer representatives with complete authority to enter into a
3 binding settlement, as well as the principal attorneys responsible
4 for the litigation, must be present and legally and factually
5 prepared to discuss and resolve the case at the mandatory
6 settlement conference and at all settlement conferences. Retained
7 outside corporate counsel shall not appear on behalf of a
8 corporation as the party representative who has the authority to
9 negotiate and enter into a settlement. Failure to attend or obtain
10 proper excuse will be considered grounds for sanctions.

11 **Confidential written settlement statements for the mandatory**
12 **settlement conference shall be lodged directly in the chambers of**
13 **Judge Brooks no later than five court days before the mandatory**
14 **settlement conference.** The statements need not be filed with the
15 Clerk of the Court or served on opposing counsel. The statements
16 will not become part of the court file and will be returned at the
17 end of the conference upon request. Written statements may be
18 lodged with Judge Brooks either by mail or in person.

19 Any statement submitted should avoid arguing the case.
20 Instead, the statement should include a neutral factual statement
21 of the case, identify controlling legal issues, and concisely set
22 out issues of liability and damages, including any settlement
23 demands and offers to date and address special and general damages
24 where applicable.

25 If appropriate, the Court will consider the use of other
26 alternative dispute resolution techniques.

27 19. Counsel shall serve on each other and file with the
28 Clerk of the Court their memoranda of contentions of fact and law

1 in compliance with Local Rule 16.1(f)(2) on or before December 23,
2 2013. On or before this date, all parties or their counsel shall
3 also fully comply with the pretrial disclosure requirements of rule
4 26(a)(3) of the Federal Rules of Civil Procedure.

5 20. Counsel shall confer and take the action required by
6 Local Rule 16.1(f)(4) on or before December 30, 2013. A personal
7 meeting between an incarcerated Plaintiff, acting in pro per, and
8 defense counsel is not required.

9 At this meeting, counsel shall discuss and attempt to enter
10 into stipulations and agreements resulting in simplification of the
11 triable issues. Counsel shall exchange copies and/or display all
12 exhibits other than those to be used for impeachment, lists of
13 witnesses and their addresses including experts who will be called
14 to testify and written contentions of applicable facts and law.
15 The exhibits shall be prepared in accordance with Local Rule
16 16.1(f)(2)(c). Counsel shall cooperate in the preparation of the
17 proposed final pretrial conference order.

18 21. The proposed final pretrial conference order, including
19 objections to any party's Fed. R. Civ. P. 26(a)(3) pretrial
20 disclosures, shall be prepared, served and lodged with the Clerk of
21 the Court on or before January 13, 2014, and shall be in the form
22 prescribed in and in compliance with Local Rule 16.1(f)(6).
23 Counsel shall also bring a court copy of the pretrial order to the
24 pretrial conference.

25 22. The final pretrial conference shall be held before the
26 Honorable Roger T. Benitez on January 21, 2014, at 10:30 a.m.

27 23. The dates and times set forth herein will not be
28 modified except for good cause shown.

1 24. Plaintiff's(s') counsel shall serve a copy of this order
2 on all parties that enter this case hereafter.

3 IT IS SO ORDERED.

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5 DATED: July 12, 2012


Ruben B. Brooks, Magistrate Judge
United States District Court

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7 cc:
8 Judge Benitez
9 All Parties of Record
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